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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,718	03/06/2002	Hiroyuki Chohsa	JP920000419US1	6846

33595 7590 11/30/2005

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EXAMINER	
HUNTSINGER, PETER K	
ART UNIT	**PAPER NUMBER**
2624	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/091,718	CHOHSA ET AL.	
	Examiner	Art Unit	
	Peter K. Huntsinger	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-15 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 06 March 2002 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 4/4/05.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. Figures 6 and 7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Price et al. Publication US 2002/0085224.

Referring to claim 1, Price et al. disclose a print instruction program, stored in a network terminal device outputting a print instruction to a printer with a PDF direct printing function linked to a communication network, for allowing said network terminal device to function as: a data control unit for controlling PDF direct print data (page 4, paragraph 63) by obtaining mouse event data and file name data on a location where a mouse pointer is positioned from a plug-in unit that adds functions to a browser program (plug-in 700 of Fig. 7, page 5, paragraph 70); a data accumulation unit for storing said file name data (RAM, page 5, paragraph 70-71); a data display unit for adding a direct print menu for a PDF file in a menu screen displayed in association with clicking of a mouse button (page 4, paragraph 63); and a data transmission unit for sending said file name data to said printer with a PDF direct printing function (page 5, paragraph 70).

Referring to claim 8, Price et al. disclose a print instruction method for outputting a print instruction from a network terminal device to a printer with a PDF direct printing function linked to a communication network, comprising the steps of: checking whether a print target file specified by a mouse pointer on a browser screen is a PDF file (page 4, paragraph 63); checking whether the specified file is to be printed by pull printing (350 of Fig. 3A, page 4, paragraph 64), if the pull printing is indicated, reading a PDF direct print menu screen by clicking a mouse while the mouse pointer is kept specifying the file (page 2, paragraph 25), storing a network address of the specified file by

selecting a menu item to execute direct printing of a PDF file on the PDF direct print menu screen (page 3-4, paragraph 56), and outputting the network address of the specified file to the printer with a PDF direct printing function (page 3-4, paragraph 56).

Referring to claim 10, Price et al. disclose wherein said step of checking whether a print target file is a PDF file checks based on indication of a file name of the print target file (page 4, paragraph 63). Price et al. do not disclose expressly determining a PDF file from the file name. It is inherent that the system of Price et al. would determine a PDF file based on the file name. Computer systems utilize file name extensions to designate a file type. The file name extension is part of the file name.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1, 3, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi et al. Publication US 2001/0049703 and Bell et al. Patent 5,301,321.

Referring to claim 1, Miyoshi et al. disclose a print instruction program, stored in a network terminal device outputting a print instruction to a printer with a PDF direct printing function linked to a communication network, for allowing said network terminal device to function as: a data control unit for controlling PDF direct print data (page 5, paragraph 72) by obtaining mouse event data and file name data on a location where a

mouse pointer is positioned (page 3-4, paragraphs 44-45) from a plug-in unit that adds functions to a browser program (page 3, paragraph 41); a data accumulation unit for storing said file name data (control number display portion 184 of Fig. 3, page 3, paragraph 44); a data display unit for adding a direct print menu for a PDF file in a menu screen (Fig. 3, page 3, paragraph 43); and a data transmission unit for sending said file name data to said printer with a PDF direct printing function (page 7, paragraph 95). Miyoshi et al. do not disclose expressly displaying a menu screen with clicking of a mouse button. Bell et al. disclose initializing a program with clicking of a mouse button (col. 3, lines 29-32). Because the menu of Miyoshi et al. is a program, it would be obvious to open a program with clicking of a mouse button. Miyoshi et al. and Bell et al. are combinable because they are from the same field of computer systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to open a program with the clicking of a mouse. The motivation for doing so would have been to enable a convenient method for opening a program. Therefore, it would have been obvious to combine Bell et al. with Miyoshi et al. to obtain the invention as specified in claim 1.

Referring to claim 3, Miyoshi et al. disclose wherein said data accumulation unit stores a plurality of PDF file names with their respective address data in a list form (Fig. 3, page 3, paragraph 44) (page 7, paragraph 94).

Referring to claim 5, Miyoshi et al. disclose wherein said direct print menu includes a menu item for displaying the list of the PDF file names stored in said data accumulation unit (page 3, paragraph 43).

Referring to claim 7, Miyoshi et al. disclose wherein said data control unit checks the address data of the files stored in said list, so that, for a file to be downloaded from a network address on the Internet, a URL of that file is sent to said printer (step 1122 of Fig. 8, page 5, paragraph 70), and for a file stored at a local address in said network terminal device, that file is sent to said printer (step 1022 of Fig. 6, page 5, paragraph 63). Miyoshi et al. do not disclose expressly a website comprising a PDF file. Official Notice is taken that it is well known and obvious in the art for a website to be a PDF file (See MPEP 2144.03). The motivation for doing so would be to provide the wide availability of a website with the advantages of a PDF file.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi et al. Publication US 2001/0049703 and Bell et al. Patent 5,301,321 as applied to claim 1, and in further view of Berstis Patent 6,018,345.

Referring to claim 2, Miyoshi et al. disclose a data control unit but do not disclose expressly changing the mouse pointer to a PDF file specific form when it has determined that said file name data is of a PDF file. Berstis discloses changing the mouse pointer to a specific form when it has determined that file name data is a link (steps 308 and 312 of Fig. 5, col. 6, lines 37-47). An HTML link is a file type and a PDF file is simply another generic type of file. Miyoshi et al. and Berstis are combinable because they are from the same field of computer systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to change a mouse pointer to a PDF specific form when located over a PDF file. The motivation for doing so would

be to alert the user that a file is a specific type with further options available for the file. Therefore, it would have been obvious to combine Berstis with Miyoshi et al. to obtain the invention as specified in claim 2.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi et al. Publication US 2001/0049703 and Bell et al. Patent 5,301,321 as applied to claim 3, and in further view of Otsuka Patent 5,579,126.

Referring to claim 4, Miyoshi et al. disclose a direct print menu but do not disclose expressly including a menu item for sequentially printing PDF files whose file names are included in the list stored in said data accumulation unit. Otsuka discloses sequentially printing documents from a list (col. 13, lines 22-26). Miyoshi et al. and Otsuka are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include a menu item for sequentially printing the list of PDF files. The motivation for doing so would be to allow the user to only select one menu item for printing a list of files opposed to having to select multiple menu items. Therefore, it would have been obvious to combine Otsuka with Miyoshi et al. to obtain the invention as specified in claim 4.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi et al. Publication US 2001/0049703 and Bell et al. Patent 5,301,321 as applied to claim 3, and in further view of Mical Patent 4,772,882.

Referring to claim 6, Miyoshi et al. disclose adding a PDF file name of a new print target at a bottom of the list of the PDF file names stored in said data accumulation unit (page 5, paragraph 60). Miyoshi et al. do not disclose expressly utilizing a menu item for adding a new file. Mical discloses utilizing a menu item for adding to a list (col. 9, lines 16-25). Miyoshi et al. and Mical are combinable because they are from the same field of computer systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include a menu item for adding files to a list. The motivation for doing so would be to provide a convenient method for adding to a list within a menu. Therefore, it would have been obvious to combine Mical with Miyoshi et al. to obtain the invention as specified in claim 6.

10. Claims 8-10, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi et al. Publication US 2001/0049703 and Mical Patent 4,772,882.

Referring to claim 8, Miyoshi et al. disclose a print instruction method for outputting a print instruction from a network terminal device to a printer with a PDF direct printing function linked to a communication network, comprising the steps of: checking whether a print target file specified by a mouse pointer on a browser screen is a PDF file (page 8, paragraph 104); checking whether the specified file is to be printed by pull printing (step 1122 of Fig. 8, page 5, paragraph 70), if the pull printing is indicated, reading a PDF direct print menu screen (page 3, paragraph 44), storing a network address of the specified file (step 1418 of Fig. 13, page 7, paragraph 89) by

selecting a menu item to execute direct printing of a PDF file on the PDF direct print menu screen (step 1408 of Fig. 13, page 7, paragraph 88), and outputting the network address of the specified file to the printer with a PDF direct printing function (step 1408 of Fig. 13, page 7, paragraph 88). Miyoshi et al. do not disclose expressly reading a menu screen by clicking a mouse while the mouse pointer is kept specifying the file. Mical discloses reading a menu by clicking a mouse while the mouse pointer is kept specifying the file (Fig. 4, col. 3, lines 44-63). Miyoshi et al. and Mical are combinable because they are from the same field of computer systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to access a menu by clicking a mouse while the pointer is kept specifying the file. The motivation for doing so would be to provide a convenient method for opening menus. Further, the standard operating system Windows utilizes clicking a mouse while the pointer is kept specifying the file and users would be familiar with the process. Therefore, it would have been obvious to combine Mical with Miyoshi et al. to obtain the invention as specified in claim 8.

Referring to claim 9, Miyoshi et al. disclose wherein if the pull printing is not indicated in said step of checking whether the specified file is to be printed by pull printing, the specified file is downloaded and saved in the network terminal device by selecting a menu item for saving an object in a file on the PDF direct print menu screen (default value save 182 of Fig. 3, page 3, paragraph 43), and said specified PDF file is outputted to the printer with a PDF direct printing function (step 1022 of Fig. 6, page 5, paragraph 63). Mical discloses the menu screen is read out by clicking the mouse while

the mouse pointer is kept specifying the file (Fig. 4, col. 3, lines 44-63). Miyoshi et al. do not disclose expressly a website comprising a PDF file. Official Notice is taken that it is well known and obvious in the art for a website to be a PDF file (See MPEP 2144.03). The motivation for doing so would be to provide the wide availability of a website with the advantages of a PDF file.

Referring to claims 10 and 12, Miyoshi et al. disclose wherein said step of checking whether a print target file is a PDF file checks based on indication of a file name of the print target file (page 8, paragraph 104).

Referring to claim 14, Miyoshi et al. disclose wherein said step of storing the network address adds said network address to a bottom of a list of PDF files to be printed (page 5, paragraph 60).

Referring to claim 15, Miyoshi et al. disclose wherein when a network address of a specified file is to be outputted to the printer with a PDF direct printing function by using the list of the files to be printed, it is determined whether pull printing or push printing is performed, depending on the address of said specified PDF file which is either a network address or a local address (step 1022 of Fig. 6, page 5, paragraph 63) (step 1122 of Fig. 8, page 5, paragraph 70). Official Notice is taken that it is well known and obvious in the art for a website to be a PDF file (See MPEP 2144.03). The motivation for doing so would be to provide the wide availability of a website with the advantages of a PDF file.

11. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi et al. Publication US 2001/0049703, Mical Patent 4,772,882 as applied to claims 10 and 12, and in further view of Berstis Patent 6,018,345.

Referring to claims 11 and 13, Miyoshi et al. disclose checking based on the indication of a file name but do not disclose determining whether a file specific mouse pointer is displayed in the vicinity of the file name. Berstis discloses changing the mouse pointer to a specific form when it has determined that file name data is a link (steps 308 and 312 of Fig. 5, col. 6, lines 37-47). An HTML link is a file type and a PDF file is simply another generic type of file. Miyoshi et al. and Berstis are combinable because they are from the same field of computer systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to determine whether a file specific mouse pointer is displayed in the vicinity of a PDF file name. The motivation for doing so would be to alert the user that a file is a specific type with further options available for the file. Therefore, it would have been obvious to combine Berstis with Miyoshi et al. to obtain the invention as specified in claims 11 and 13.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tanaka Patent 6,519,048.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH

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